

REMARKS

The outstanding Office Action addresses claims 1-37. Applicants cancel claims 16-36 as being directed to a non-elected species. Applicants reserve the right to pursue these claims in a continuation application. Claims 1-15 and 37 stand rejected.

Applicants amend independent claims 1 and 37 to recite first and second opposed tissue penetrating claws that are biased to one of the open and closed positions. This limitation was previously recited in cancelled claim 2. Claims 3, 5, and 6 are amended to depend from claim 1, rather than cancelled claim 2. No new matter is added.

35 U.S.C. §102(b)

Claims 1, 2 and 37 are rejected pursuant to 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,954,057 of Li. The Examiner argues that Li discloses, in Figures 16 and 17, “a suspension clip assembly 200 having tissue penetrating claws 206 movable between an open and closed position by actuating member 220 and a suspension strap 212 which may be a suture (flexible member), wire, web, chain or the like” Applicants respectfully disagree.

Li does not teach or even suggest a suspension clip assembly having opposed tissue penetrating claws that are biased to one of an open position and a closed position. As shown in Figure 16, Li discloses a suspension clip having four legs 206, and an emplacement tool 220 for locking the clip assembly to soft tissue. The emplacement tool 220 is effective to *permanently* bend the legs at their juncture and “thereby securely lock[] the suspension clip assembly to the soft tissue (FIG. 19).” (Col. 15, lines 48-50). The suspension strap 212 can then be “fixed to another body part, such as bone B, so as to suspend the soft tissue S from the bone B” (Col. 15, lines 63-65). Since the suspension clip assembly has legs that can only be moved once from an open to a closed position, the *penetrating claws* cannot be *biased* to one of the open or closed positions. The biasing feature of Applicants’ invention allows the claws to be repeatedly moved between the open and closed positions to grasp and release tissue, as desired. Li does not teach or even suggest such a feature, and in fact, any biasing mechanism would defeat the intended

purpose of the Li device, which is to provide a clip assembly for *permanently* securing soft tissue to another body part, such as bone. Accordingly, independent claims 1 and 37 distinguish over Li and therefore define patentable subject matter. Claims 3-15 are allowable at least because they depend from an allowable base claim.

35 U.S.C. §103(a)

The Examiner further rejects claims 1-15 and 37 pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,893,878 of Pierce in view of U.S. Patent No. 5,954,057 of Li.

The Examiner maintains the argument that it would have been obvious to modify the device taught by Pierce to include a suspension strap as taught by Li. Specifically, the Examiner argues that “to take a perfecting feature, namely a flexible member for the purpose of suspension, from one tissue grasping member and providing it on another tissue grasping member would have been an obvious modification.” (Office Action, page 5.) Applicants again respectfully disagree.

The Examiner has failed to identify the necessary motivation to combine the references, and therefore has not established a prima facie case of obviousness. The suspension strap of Li cannot simply be added to the Pierce device because it is a “perfecting feature.” There must be some motivation to combine the references. Li and Pierce, however, are distinct devices used for different purposes which would preclude one skilled in the art from combining Li’s suspension strap with Pierce’s device in order to create a device as taught by the present invention.

As shown in Figure 1 of Pierce and Figure 16 of Li, which are reproduced below, Pierce and Li disclose two very distinct devices. Pierce discloses an apparatus for temporarily grasping and manipulating tissue, while Li discloses a suspension clip for permanently attached soft tissue to bone. Pierce’s device is a single elongate, rigid member having a proximal handle for actuating opposed tissue grasping members. Li’s device is a four-pronged clip and a separate emplacement tool for bending the legs of the clip to permanently attached the clip to tissue.

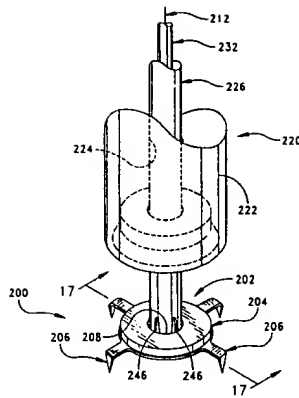


FIG. 16

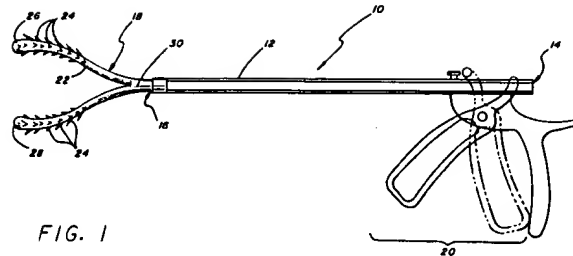


FIG. 1

Accordingly, Pierce and Li disclose distinctly different devices. These differences alone are sufficient to preclude one skilled in the art from combining Li's suspension strap with Pierce's device in order to create a device as taught by the present invention.

Applicants further note that the fact that Pierce already provides a handle for manipulating the tissue being grasped is evidence enough that one of ordinary skill in the art would not be motivated to provide a suspension strap, as taught by Li. Moreover, not only does Pierce already provide a handle for manipulating the device, but a suspension strap *cannot* be used with Pierce, at least not without significantly and pointlessly modifying the Pierce device. Pierce is a rigid, elongate scissor-type device having a trigger mechanism used to actuate opposed grasping members. The rigid, elongate shape of the device would make it very difficult to hold and manipulate using a flexible elongate member. Moreover, the flexible member would be meaningless since it cannot be used to hold and manipulate the tissue. The Pierce device lacks any type of locking mechanism to lock the levers 48 and 50 in one of the open or closed positions, thus tissue can only be grasped and manipulated by holding the levers in the closed position. The necessity to hold the handles of the Pierce device would render a suspension strap useless.

In sum, there is no suggestion or motivation to modify Pierce to include any type of flexible member, much less the flexible member taught by Li, and the use of such a flexible

member would be meaningless. Accordingly, the Examiner has failed to provide motivation to combine the references, and therefore independent claims 1 and 37 are not obvious over Pierce in view of Li and represent allowable subject matter.

Conclusion

In view of the amendments and remarks above, Applicants submit that claims 1, 3-15, and 37 are in condition for allowance. Applicants encourage the Examiner to telephone the undersigned in the event that such communication might expedite prosecution of this matter.

Respectfully submitted,

Date: April 30, 2003



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